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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,113	10/25/2000	Louis Bouchard	LUCENT-01701	3907

28960 7590 12/31/2003

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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/697,113

Applicant(s)

BOUCHARD ET AL.

Examiner

Jerry B Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,5.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

#### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to

specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the

applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (k) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

1. The specification must contain the above content. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldfinger et al. (U.S. Patent Num 6,449,344).
4. Regarding claims 1 and 20, Goldfinger discloses a method and system of providing message notification for a user in an instant messaging system comprising the steps of:

registering a message notification application to at least one instant messaging service (col. 5, lines 35-50, Goldfinger teaches notifying that the user is connected to the system);

signing a user onto the message notification application by adding the user to a buddy list of the message notification application (col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system); and

sending an instant message notification to the user when a message arrives for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user).

5. Regarding claims 2 and 21, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 1 and 20, including wherein the step of sending an instant message notification is performed by sending the instant message notification to the user through the at least one instant messaging service (col. 6, lines 35-50, Goldfinger teaches that messages go through the server).

6. Regarding claims 3 and 22, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 1 and 20, including retrieving the message by accessing a server (col. 6, lines 40-45, Goldfinger teaches the server sending a message after checking if the user is still connected).

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7. Regarding claims 4 and 23, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including wherein the server is one of an application, a voice messaging and a unified messaging server (col. 5, lines 30-35).

8. Regarding claims 5 and 24, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including accessing the server by one of sending a request to the message notification application and using a telephone (col. 5, lines 24-30).

9. Regarding claims 6 and 25, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including retrieving messages from the server by an internet appliance (col. 5, lines 25-30).

10. Regarding claims 7 and 26, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claim 3 and 22, including deleting a message using the internet appliance without retrieving the message from the server (col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages).

11. Regarding claims 8 and 14, Goldfinger discloses an apparatus and system for providing message notification where and when a user is most likely to hear or see

notification and allowing the user to instantly review new messages (col. 2, lines 19-45) comprising:

- a. at least one instant messaging service (col. 4, lines 49-60);
- b. a message notification application having a buddy list and registered to the at least one instant messaging service (col. 6, lines 3-15, Goldfinger teaches users having a list of sought users);
- c. a server for storing messages and providing a medium for the message notification application to operate (col. 6, lines 35-50, Goldfinger teaches of a server); and
- d. an internet appliance to access the server and receive an instant message notification (col. 6, lines 50-65, Goldfinger teaches users on a computer terminal being able to receive messages).

12. Regarding claims 9 and 15, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein in response to a user signing up to receive messages with the message notification application the user is automatically added to the buddy list of the message notification application (col. 5, line 35 through col. 6, line 25, Goldfinger teaches a list of users updated when they sign on to the system).

13. Regarding claims 10 and 16, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein



the message notification application sends the user the instant message notification through the at least one instant messaging service when a message arrives for the user (col. 6, lines 35-50).

14. Regarding claims 11 and 17, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including retrieving the message from the server by one of sending a request to the message notification application and using a telephone (col. 5, lines 24-30).

15. Regarding claims 12 and 18, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including wherein the server is one of an application, a voice messaging and a unified messaging server (col. 5, lines 30-35).

16. Regarding claims 13 and 19, Goldfinger shows all of the features of the invention, substantially as claimed, as described in claims 8 and 14, including deleting the message using the Internet appliance without retrieving the message from the server (col. 6, lines 50-65, Goldfinger teaches authorization for users to decide which users can send them messages).

17. Regarding claim 27, Goldfinger discloses a method of providing a voice messaging notification application for a user in an instant messaging system comprising the steps of:

- a. registering a message notification application to at least one instant messaging service (col. 5, lines 35-50, Goldfinger teaches notifying that the user is connected to the system);
- b. adding a user to a buddy list of the instant messaging service (col. 6, lines 3-35, Goldfinger teaches a server containing a list of connected users which updates the lists of sought users predefined by users connected to the system);
- c. sending an instant message notification to the user when a message arrives for the user (col. 6, lines 35-50, Goldfinger teaches a server sending a message to a user when it arrives from another user); and
- d. allowing the user access to a server by one of using an internet appliance and using a telephone(col. 5, lines 24-30).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry B Dennison whose telephone number is (703)305-8756. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

JBD  
Patent Examiner  
Art Unit 2143  
12-17-03



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100